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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,421	03/25/2005	Hermann Hofbauer	10901/74	6666

26646 7590 05/31/2007
KENYON & KENYON LLP
ONE BROADWAY
NEW YORK, NY 10004

EXAMINER

KHUU, HIEN DIEU THI

ART UNIT	PAPER NUMBER
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2863

MAIL DATE	DELIVERY MODE
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05/31/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/529,421	HOFBAUER ET AL.	
	Examiner	Art Unit	
	Cindy D. Khuu	2863	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-22 and 24 is/are pending in the application.
- 4a) Of the above claim(s) 10-14 and 22 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-21 and 24 is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

QUAYLE ACTION

This application is in condition for allowance except for the following formal matter:

The presence of claims 10-14 and 22 are directed to an invention non-elected with traverse in the reply filed on 05/25/2006.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213, (Comm'r Pat. 1935).

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

Pertinent Art Cited

The following US Patent Applications reveal the current state of the art:

Tondorf (US 6,114,947) teaches a measuring system for correct functioning (Fig. 1), comprising:
the measuring system (1), transmitting (5), by a measurement device (1) to a second device (2) via a data-transmission device (5), a bit (S_D) having a constant level to signal a fault-free (activation signal) operation of the measuring device (Columns 3-4; lines 64-67 and 1-10 respectively);
electrically contacting a signal-monitoring circuit of the measuring device with a test-potential source (Fig. 4, 109-110; Column 7, lines 1-16); and
outputting test data conditional upon a determination (Column 2, lines 42-47).

However, Tondorf does not teach at least a normal operation of the measuring system, a test operation of the measuring system and checking whether the test operation effects a change in a level of the bit in relation to the level of the bit in the normal operation.

Allowable Subject Matter

Claims 15-21 and 24 are allowed.

The following is a statement of reasons for the indication of allowable subject matter:

The primary reason for the allowance of claim 15 is the inclusion of the limitation "checking whether the test operation effects a change in a level of the bit in relation to the level of the bit in the normal operation". The prior art of record, taken alone or in combination, fails to disclose or render obvious.

Claims 16-21 and 24 are allowed due to their dependency on claim 15.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

Applicant's arguments filed 05/01/2007 have been fully considered but they are not persuasive.

Regarding to the restriction requirement under 35 U.S.C. 121 and 372, Applicant argues that no consideration has been given to whether Group I (Claims 10-14 and 22) and Group II (Claims 15-21 and 24) involve one or more of the same or corresponding special technical features and that no comparison has apparently been made at all to the prior art.

Examiner will recite Rule 13 under Unity of Invention as followed:

13.2 Circumstances in Which the Requirement of Unity of Invention Is to Be Considered Fulfilled
Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall

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mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

Examiner's position is that the "special technical feature" that is the contribution over prior art is "checking whether the test operation effects a change in a level of the bit in relation to the level of the bit in the normal operation". However, this special technical feature is not commonly found in Group I of claims 10-14 and 22. The restriction requirement is still deemed proper and therefore Examiner will maintain the restrictions.

Fax/Telephone Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cindy D. Khuu whose telephone number is (571) 272-8585. The examiner can normally be reached on M-F, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow can be reached on (571) 272-2269. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

5/23/07 *cmk*

John Barlow
John Barlow
Supervisory Patent Examiner
Technology Center 2800